

**REMARKS**

In the Office Action<sup>1</sup>, the Examiner took the following actions:

rejected claims 30-50 under 35 U.S.C. § 101 as being directed to non-statutory subject matter;

rejected claims 1-2, 5-17, 30-31, and 34-54 under 35 U.S.C. § 112, first paragraph; and

allowed claims 3 and 4.

Applicant has amended claims 4-6, 11, 14, 17, 30-46, 48-51, and 53 to more appropriately define the invention. Claims 1-17 and 30-54 remain pending in this application.

**I. Examiner Interview of June 10, 2008**

Initially, Applicant wishes to thank the Examiner for granting the telephonic interview on June 10, 2008 with Applicant's representative. Further, Applicant wishes to thank the Examiner for discussing the proposed claim amendments. Applicant asserts that claims 4, 6, 11, 14, 17, 33, 35, 40, 43, 46, 48, and 50, as previously presented, fully meet all requirements of the statute. Nevertheless, to advance prosecution, Applicant has amended claims 4, 6, 11, 14, 17, 33, 35, 40, 43, 46, 48, and 50, to recite "a first request" and "a second request" based on the Examiner's suggestion. Accordingly, Applicant respectfully requests the Examiner to reconsider the claims and, for the reasons stated below, withdraw all of the rejections.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

## II. Rejection of claims 30-50 under 35 U.S.C. § 101

The Examiner rejected claims 30-50 under 35 U.S.C. §101, alleging that the claims are “directed to non-statutory category invention.” Office Action, page 2. Applicant respectfully traverses this rejection. However, to advance prosecution, Applicant has amended independent claims 30, 32, 36, and 41 to recite a “computer-readable **storage** medium containing instructions which, when executed by a processor, perform a method,” and amended dependent claims 31, 33-35, 37-40 to recite a “computer-readable **storage** medium” (emphasis added). Thus, claims 30-50 recite statutory subject matter even more clearly.

The Examiner is reminded of the guidelines provided in the M.P.E.P.

Specifically, the M.P.E.P. states:

When a computer program is claimed in a process where the computer is executing the computer program's instructions, USPTO personnel should treat the claim as a **process claim**. When a computer program is recited in conjunction with a physical structure, such as a computer memory, USPTO personnel should treat the claim as a **product claim**. See M.P.E.P. § 2106.01 (emphasis added).

In view of the foregoing, Applicant submits that claims 30-50 squarely fall within the categories of patentable subject matter. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 30-50 under 35 U.S.C. §101.

## III. Rejection of claims 1, 2, 5-17, 30, 31, and 34-54 under 35 U.S.C. § 112, first paragraph

Applicant respectfully traverses the rejection of claims 1, 2, 5-17, 30, 31, and 34-50 under 35 U.S.C. § 112, first paragraph. The Examiner asserted that, “the original

specification does not support the concept of making the selection of the medium based on a communication protocol.” See Office Action, page 3. However, this is not correct.

The MPEP states:

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention . . . the claimed invention be enabled so that any person skilled in the art can make and use the invention without **undue experimentation**. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (“**The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.**”). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991) . . . **Any part of the specification can support an enabling disclosure, even a background section** that discusses, or even disparages, the subject matter disclosed therein. *Callicrate v. Wadsworth Mfg., Inc.*, 427 F.3d 1361, 77 USPQ2d 1041. See M.P.E.P. § 2106.04 (emphasis added).

Applicant submits that selecting a channel “based on the communication profile” is fully supported by the specification because one of reasonable skill in the art will be able to make and use the invention without undue experimentation. Further, at least the following excerpts from Applicant’s specification fully enable the above-noted element of Applicant’s claimed invention:

**[c]ommunication profiles** are the detailed communication parameters that **must be utilized** by one network entity **wishing to communicate with another** network device operating on the ICS network. Specification at page 8, lines 8-11 (emphasis added).

The **ICS module** operating on the point of care terminal or the ICS network, **scans all the available PCMCIA communication channels** and **selects the optimum channel** to establish the connection. **To accomplish this function**, the ICS module **interfaces with a communication profile database to retrieve communication profile data** and other interface parameters of the receiving station. Specification at page 10, line 27-page 11, line 5 (emphasis added).

Local ICS module 304 provides the point of care terminal with the capability to communicate with network servers (40 and 42) and the ICC database server 50 **using several attached communication channels**. ICS module 304 evaluates the user's location relative to the wireless Ethernet installed inside of the hospital, and **performs the functions necessary** to establish the most economical and efficient data communication link **based on the user's location**. Specification at page 15, lines 18-23 (emphasis added).

Moreover, even assuming that selecting a channel "based on the communication profile" is not fully disclosed in the specification, which Applicant does not concede, original claims filed August 30, 1999 specifically recite "attempting to **establish a communication link** with said network server using one of a plurality of **communication media, in accordance with said communication protocol**" (claims 1, 29, and 30 (emphasis added)) and "configuring said portable access device to transmit **using one of a plurality of communication media in accordance with said communication protocol**" (claims 10, 16, 39, and 45 (emphasis added)), where communication profiles comprise the communication protocols. Specification at page 23, lines 26-28.

Regarding the original claims, the M.P.E.P. states

[i]n establishing a disclosure, applicant may rely not only on the description and drawing as filed **but also on the original claims** if their content justifies it.

Where subject matter not shown in the drawing or described in the description **is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits**, and requirement made to amend the drawing and description to show this subject matter. **The claim should not be attacked either by objection or rejection** because this subject matter is lacking in the drawing and description. It is the drawing and description that are defective, not the claim. See M.P.E.P. § 608.01(l) (emphasis added).

In view of at least the foregoing reasons, one of reasonable skill in the art will be able to make and use the invention without undue experimentation. Therefore, Applicant asserts that claims 1, 2, 5-17, 30, 31, and 34-50 are enabled and fully meet the requirements of 35 U.S.C. § 112, first paragraph.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 2, 5-17, 30, 31, and 34-50 under 35 U.S.C. § 112, first paragraph.

Regarding the rejection of claims 51-54 under 35 U.S.C. § 112, first paragraph, the Examiner asserts that, "a second attempt to establish communication via a remote wireless Ethernet network, or a cellular transmission network or a portable radiotelephone transceiver network, if the first attempt fails . . . is not supported in the original specification." Office Action, page 4. However, this is not correct.

While Applicant disagrees with the Examiner's rejection, Applicant has amended claims 51 and 53 to recite a "initiating a second attempt to establish communication via a remote wireless network if the first attempt fails," in an effort to advance prosecution. As was discussed in the interview with the Examiner, establishing communication via a wireless network is fully supported in the specification and one reasonably skilled in the

art would be able to make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.

For example, the specification states, “[t]here is a need therefore for an improved apparatus and method for **providing wireless or wireline access** to a medical information computer network via remote computers.” Specification page 6, lines 2-3 (emphasis added). Further,

[i]f a communication link cannot be established, the local ICS module then attempts to initiate a communication link via the portable **radiotelephone transceiver 308** . . . [i]f the communications profile for the desired network server is not stored on-board the point of care terminal (20 or 22), the ICS module 304 initiates communication with the ICC database server 50 utilizing the same scheme previously discussed (i.e. **local wireless Ethernet, then remote wireless Ethernet, and then PSTN**). Specification at page 16, lines 8-23 (emphasis added).

Moreover, the background section of the specification and the original claims provide multiple recitations of the use of wireless network, thus enabling one of reasonable skill in the art to make or use the invention without undue experimentation. Applicant submits that for at least the foregoing reasons claims 51-54 are enabled and fully meet the requirements of 35 U.S.C. § 112, first paragraph.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 51-54 under 35 U.S.C. § 112, first paragraph.

**CONCLUSION**


In view of the foregoing amendment and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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